

REMARKS

Claims 1-18 are pending in the Application. Claims 6, 7, and 9 have been amended. Claims 17 and 18 have been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Priority

The Specification has been amended as suggested by the Examiner to claim the benefit of an earlier application. The Examiner's suggested language is appreciated.

Specification

The Specification has been amended at page 17 as suggested by the Examiner to reference the aperture as numeral "125". Additional support for "aperture 125" may be found at page 16, line 22; and page 18, line 1. The Examiner is thanked for bringing the typographical error to Applicants' attention.

The 35 U.S.C. § 103 Rejections

For brevity the Applicants have not necessarily presented all the reasons as to why the applied references do not render the claims obvious. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments show that the applied references neither

taken alone or in combination disclose or suggest all of the steps, features, and relationships of the claimed invention. Hence, Applicants' claims patentably distinguish over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn. It follows that the claims which depend from the independent claims are likewise allowable.

Applicants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new grounds of rejection.

The Legal Standard

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie obviousness*, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of

obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

**The Pending Claims Are Not Obvious Over
Caldwell in view of McCall**

In the Action claims 1-3, 5-8, and 10-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell in view of McCall. These rejections are respectfully traversed.

Applicants traverse these rejections on the grounds that Applicants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

Caldwell does not disclose or suggest the features and relationships that are specifically recited in the claims. The Action relies on Caldwell to disclose a night depository method. However, the Action admits that "Caldwell fails to teach a use of a cover extending from a receipt dispensing slot, wherein the cover includes an aperture." The Action then alleges that it would be obvious to employ a night depository machine having a receipt delivery system with a cover. The Action then further alleges that McCall teaches a cover with an aperture. The Action then alleges that one would be motivated to add a cover with an aperture to protect a receipt delivery system from infiltration of contaminants, etc.

The Applicants disagree. McCall cannot overcome the admitted deficiencies of Caldwell as it does not disclose or suggest the recited features which are not found in Caldwell. The Action is silent as to how Caldwell could be modified by McCall to include the recited features and relationships. The Action is devoid of any such teaching, suggestion, or motivation for combining the references. Neither Caldwell nor McCall alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims.

Claim 1

Claim 1 is an independent claim which is specifically directed to a method. The claim recites many steps which Caldwell does not disclose. For example, the claim specifically recites “extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user.”

The Action alleges that Caldwell discloses a receipt dispensing slot (40). However, the Action admits that “Caldwell fails to teach a use of a cover extending from a receipt dispensing slot, wherein the cover includes an aperture.”

The cited art fails to teach an overlying member (apparently referenced as a “cover” in the Action) in regard to a receipt at a deposit accepting machine. The cited art further fails to teach the overlying member having an aperture therein sized for accepting a finger of a user. Neither Caldwell nor McCall, taken alone or in combination, disclose or suggest an overlying member with an aperture (or even an overlying member) in the manner recited. Neither Caldwell nor McCall, taken alone or in combination, disclose or suggest extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes

an aperture therein sized for accepting a finger of a user in the manner recited. Neither Caldwell nor McCall, taken alone or in combination, disclose or suggest moving a receipt in a sandwiched relation between a finger and the exterior wall of the machine in the manner recited.

McCall is non-analogous art

McCall is non-analogous art. McCall is directed to a fuel dispenser. Claim 1 relates to deposit accepting. McCall's dispensing is actually opposite to deposit accepting. Thus, McCall teaches away from the recited invention. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

McCall is also non-analogous art because there is no indication that McCall is directed to moving a receipt. Claim 1 is directed to moving a receipt. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

No evidence has been presented that McCall issues a receipt

There is no indication that McCall discloses or suggests issuing a receipt. Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. It follows that McCall's teaching cannot be used with a receipt delivery system as alleged. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

The Action's reasons for obviousness are not valid

The Action alleges that it would be obvious to employ a night depository machine having a receipt delivery system with a cover. The Action then alleges that one would be motivated to add the cover with an aperture, as allegedly taught by McCall, to protect the receipt delivery system from infiltration of contaminants.

It is unclear how one would be motivated to add an aperture to a cover of a receipt delivery system of a night depository machine to protect the receipt delivery system from infiltration of contaminants. It would appear that a cover without an aperture (e.g., solid cover) would provide the best protection against contaminants. It would appear that the addition of an aperture in the cover would actually increase the probability of entered contaminants. Thus, the alleged motivation for obviousness is inadequate. The Action's reasons for obviousness are flawed. Therefore, the Action has not presented a valid basis for obviousness. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

No evidence has been presented of an overlying member including an aperture therein

The Action alleges that McCall teaches extending a receipt intermediate of an exterior wall of the machine and a cover (which apparently serves as an overlying member). The Applicants disagree. There is no indication that McCall discloses or suggests a cover with an aperture.

The Action is silent as to where the alleged cover is located in McCall. No evidence has been presented of an overlying member including an aperture therein. As previously discussed, before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of

establishing that all the recited features of the claim are known in the prior art. Furthermore, the features in prior art references must be clearly and particularly identified to support a rejection on the basis of obviousness. Applicants should not be forced to speculate as to what member constitutes the alleged cover (overlying member) in McCall. It is respectfully submitted that the rejection be withdrawn on this basis.

Applicants' discussions involving the McCall reference are no admission that McCall actually discloses the mentioned features. Applicants do not waive any rights regarding the complete absence of any disclosure in McCall regarding a receipt delivery system or an overlying member including an aperture therein.

None of McCall's members can constitute the recited overlying member

The Action admits that Caldwell fails to teach a night depository receipt delivery system having a cover with an aperture. The Action relies on McCall as teaching a cover with an aperture. The Applicants disagree. As previously discussed, no evidence has been presented that McCall teaches extending a receipt intermediate of an exterior wall of a machine and a cover. As no such showing has been made the rejection is not in compliance with MPEP § 2142 and should be withdrawn.

Furthermore, the structure, function and operation of the (unreferenced) member in McCall's Figure 1 which is located below display (20a) and to the right of reader device (22) is unclear. Thus, the structure and operation of McCall's unreferenced member are open to many different interpretations. Each such interpretation is purely speculative. Rejections cannot be based upon speculation or possibilities. *In re Robertson*, 169 F. 3d 749 (Fed. Cir. 1999).

Nevertheless, said unreference member in McCall's Figure 1 cannot constitute the recited overlying member.

In one speculated interpretation of McCall's unreference member the uppermost (cup-shaped) portion of the unreference member appears to show that the unreference member is recessed into the exterior wall (16) of the fuel dispenser. If this member was involved with delivering receipts (and there is no evidence that it is), at best, any receipt would appear to be interior of both a cover and the exterior wall (16). However, claim 1 recites that a receipt is extended intermediate of an exterior wall and an overlying member. Hence, McCall cannot alleviate the admitted deficiencies in Caldwell. Thus, a combined Caldwell and McCall would still lack the recited steps, features, and relationships. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

Furthermore, because the uppermost (cup-shaped) portion of the unreference member appears to show the member as being recessed (again a purely speculative interpretation), then any receipt would have to be pulled through what may be an opening (e.g., U-shaped) in order to be obtained by a customer. That is, because of the recess a receipt could not be removed from the bottom of the member. Hence, a finger would have to be inserted behind a receipt in order to pull the receipt through the opening. In McCall, at best, any receipt would be in sandwiched relation between a first finger and a second finger (thumb). Therefore, McCall would also lack the recited step of moving a receipt in sandwiched relation between a finger and the exterior wall. Hence, McCall cannot alleviate the admitted deficiencies in Caldwell. Thus, a combined

Caldwell and McCall would still lack the recited steps, features, and relationships. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

Additionally, in another (second) speculative interpretation, the unreferenced member in McCall's Figure 1 which is located below display (20a) and to the right of reader device (22) may constitute a door for restricted access to the interior of the fuel dispenser. In such a second speculated interpretation, McCall is not even involved with a receipt.

In still another (third) speculative interpretation, said unreferenced member in McCall may constitute a clear plastic drawer which can be either tilted outward or slid upwardly by a customer to enable the customer to gain access to a receipt in the recessed interior portion. In such a third speculated interpretation, any receipt would not be moved in sandwiched relation.

In still another (fourth) speculative interpretation, said unreferenced member in McCall may constitute an outlet for presenting coupons, without involving a receipt.

In still another (fifth) speculative interpretation, the un referenced member in McCall may be part of a bill acceptor which enables a user to pay by inserting cash into the machine.

It follows that no matter which speculated interpretation of the unreferenced member in McCall is used, even if it were somehow possible for Caldwell to include the teachings of McCall, the modified Caldwell would still lack the recited steps, features, and relationships. McCall cannot alleviate the admitted deficiencies in Caldwell. Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

Caldwell has no need for a cover

The Action alleges that Caldwell discloses a receipt dispensing slot (40). However, the Action admits that “Caldwell fails to teach a use of a cover extending from a receipt dispensing slot, wherein the cover includes an aperture.”

Caldwell has no need for a cover. Caldwell’s receipt dispensing slot (40) is already protected by the recessed customer interface (26). Additionally, the slot (40) permits a receipt to be directly presented to a customer. It appears that the arrangement enables a customer to easily grasp the presented receipt by hand. In Caldwell it is not necessary (nor desired) to move the receipt in the recited sandwiched relation.

Furthermore, Caldwell does not structurally permit moving a receipt in the recited sandwiched relation. This is because Caldwell does not disclose or suggest an overlying member with an aperture (or even an overlying member) in the manner recited. Even the Action admits that Caldwell fails to teach a night depository receipt delivery system having a cover with an aperture. Thus, the Action is devoid of any such teaching, suggestion, or motivation for extending a cover (overlying member) from Caldwell’s receipt dispensing slot (40) as alleged. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants’ recited invention.

The alleged modification to Caldwell would destroy the disclosed utility of Caldwell

As previously discussed, it would not have been obvious to have added McCall’s teaching to Caldwell. Nevertheless, even if it were somehow possible for Caldwell to include the teachings of McCall, the modified Caldwell would still lack the recited features and

relationships. For example, the combined Caldwell would still lack the capability of moving a receipt in a sandwiched relation between a finger and the exterior wall of the machine in the manner recited.

As previously discussed, Caldwell's receipt dispensing slot (40) is protected by a recessed customer interface (26). Additionally, a receipt would appear to exit the slot (40) in a horizontal direction toward the customer (i.e., generally perpendicular to the slot housing). A modification of Caldwell with the alleged McCall would change the desired direction of a receipt exiting Caldwell's slot (40).

If it were somehow possible for the unreferenced member in McCall to present a receipt intermediate of an exterior wall of the machine and a cover as alleged, then the receipt would not be presented in the same direction as Caldwell's receipt. That is, even if it were somehow possible for McCall's unreferenced member to be added to the structure of McCall, then the modified Caldwell would not present a receipt in the same direction as the unmodified Caldwell. Modification of Caldwell with McCall's unreferenced member as alleged would not permit a receipt to be presented to a customer in the direction (generally perpendicular to the slot housing) desired in Caldwell. That is, the alleged modification to Caldwell would destroy the disclosed and desired utility or operability of the Caldwell teaching.

An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it

would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention.

The alleged cover of McCall is not capable of fitting into the structure of Caldwell

Furthermore, the alleged cover of McCall is not capable of fitting into the compact (and perhaps away-angled) interface structure of Caldwell. The location and arrangement of Caldwell's slot (40) would prevent the alleged modification. Caldwell's entire interface structure and receipt delivery system would have to be dramatically modified to be able to present a receipt intermediate of an exterior wall of the machine and a cover as alleged. Additionally, if Caldwell's slot interface is angled away from the customer, then one skilled in the art would not have attempted to modify the structure of Caldwell to require moving a receipt in a sandwiched relation, because the receipt would have to be moved in a direction away from the customer. Hence, the alleged modification to Caldwell would destroy the operability of the desired Caldwell arrangement. As previously discussed, an obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references.

Furthermore, such an alleged modification would clearly be an attempt at hindsight reconstruction of Applicants' claimed invention, which is impermissible. The Action has not shown any reason or motivation to combine, or explained how the incompatible (alleged) structure of McCall could be incorporated into the structure of Caldwell. The Action has not shown any reason or motivation why one skilled in the art would even attempt to merge incompatible features, which would require a dramatic change to the structure of Caldwell.

Applicants have shown that the claim is patentable over Caldwell in view of McCall

Applicants have shown that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest extending a receipt intermediate of an exterior wall of the machine and an overlying member in the manner recited.

Applicants have also shown that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user in the manner recited.

Applicants have also shown that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest moving a receipt in a sandwiched relation between a finger and the exterior wall of the machine in the manner recited.

Applicants have also shown that neither Caldwell nor McCall disclose or suggest the recited steps, features, and relationships. Nor would it have been obvious to have combined the teachings of Caldwell and McCall. Nor would it have been obvious to have combined the teachings of Caldwell and McCall to have produced Applicants' recited invention. Furthermore, Applicants have also shown that even if it were somehow possible for Caldwell to include the teachings of McCall, the modified Caldwell would still lack the recited steps, features, and relationships. It follows that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in the claim.

Claim 16

Claim 16 is an independent method claim. Claim 16 recites subject matter similar to subject matter in claim 1. Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Thus, it is respectfully submitted that claim 16 also patentably distinguishes over the applied references.

The Dependent Claims

Each of the dependent claims depend directly or indirectly from an independent claim. Each independent claim has been previously shown to be allowable. It is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recite specific steps, features, and relationships that patentably distinguish the claimed invention over the applied art. Neither Caldwell nor McCall, alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that these dependent claims are further allowable due to the recitation of such additional steps, features, and relationships.

Claims 2 and 3 are directed to the manner in which a receipt is moved. Neither Caldwell nor McCall disclose or suggest the recited movement. Furthermore, it would appear that the movement of Caldwell's receipt would be in direct conflict with the generally downward direction of claim 3.

Claim 5 depends from claim 4. The Action admits that Caldwell as modified by McCall fails to teach the subject matter of claim 4. It follows that Caldwell as modified by McCall fails to teach the subject matter of claim 5.

Claim 6 is directed to relationships involving an exterior wall opening, overlying member, edge, or aperture. None of the applied references disclose or suggest such relationships.

Claim 7 indicates that a receipt extending between the exterior wall and the overlying member cannot be manually grasped prior to movement with a finger. In Caldwell a receipt can be grasped from the dispensing slot (40). As previously discussed, McCall does not teach a receipt or a receipt dispensing arrangement. Nevertheless, it would appear that McCall's unreferenced member would permit grasping of an item prior to movement with a finger.

Claim 8 is directed to the manner in which a receipt is moved. None of the applied references disclose or suggest that a receipt is moved by downward movement of a thumb.

Claims 10 and 11 are directed to indicia printed on a receipt. None of the applied references disclose or suggest printed indicia in the manner recited.

Claim 12 is directed to placing a deposit article. None of the applied references disclose or suggest conducting a transaction in the manner recited.

Claim 13 depends from claim 12. None of the applied references disclose or suggest that a depository door is unlocked responsive to both input of a card and placing of a key.

Claim 14 is directed to fitting a panel on an exterior surface of an existing deposit accepting machine. None of the applied references disclose or suggest fitting in the manner recited.

Claim 15 depends from claim 14. None of the applied references disclose or suggest indicia printed in the manner recited.

**The Pending Claims Are Not Obvious Over
Caldwell in view of McCall and Imai**

In the Action claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell in view of McCall and Imai. These rejections are respectfully traversed.

As previously discussed, neither Caldwell nor McCall alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims.

Furthermore, even the Action admits that Caldwell as modified by McCall fails to teach cutting a paper with a cutter.

Claim 4

Claim 4 is directed to cutting paper with a cutter. Imai does not disclose or suggest cutting paper prior to moving a receipt in sandwiched relation in the manner recited. Imai cannot alleviate the admitted deficiencies in Caldwell (as modified by McCall). Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall and Imai to have produced Applicants' recited invention.

Claim 9

Claim 9 is directed to cutting a receipt with a cutter. Imai does not disclose or suggest that movement of a receipt in sandwiched relation is operative to cut the receipt in the manner

recited. Imai cannot alleviate the admitted deficiencies in Caldwell (as modified by McCall). Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall and Imai to have produced Applicants' recited invention.

The New Claims

Claim 17 is directed to removing a receipt through an opening formed between an overlying member edge and the exterior wall. In an exemplary embodiment of the invention persons are prevented from pulling excess paper outward through the receipt outlet. None of the references disclose or suggest preventing persons from pulling excess paper outward through the receipt outlet. Nor do the references disclose or suggest removing a receipt in the manner recited.

Claim 18 includes a combination of subject matter from claims 3, 6, 7, and 16. None of the references disclose or suggest the recited steps, features, and relationships of claim 18.

Versions With Markings To Show Changes Made

In the Specification

Paragraph beginning on Specification page 16, line 13 and ending on Specification page 17, line 3:

In the exemplary embodiment these desirable features are accomplished by the configuration of the overlying member 30, which overlies an opening 113 in a wall 115 of the control panel. The overlying member extends generally downward from above the opening 113 to a lower edge 119. The length of the overlying member 30 from the opening 113 to the lower edge 119 is sufficient to enable a substantial portion of the length of a receipt to extend therein. An interior surface of the overlying member 30 is disposed from an exterior wall surface 121 of the control panel a sufficient distance to enable the receipt paper to pass therethrough. However the distance between the interior of the overlying member 30 and the wall surface 121 is sufficiently small so that a user's fingers cannot be generally extended into the space therebetween. The overlying member 30, as best shown in Figure 39, includes an [a] aperture 125 that extends into the overlying member from the lower edge 119. The aperture is generally centered relative to the path of the receipt paper and is sized to accept a user's finger therein. In the exemplary embodiment the aperture 125 [135] is sized such that a user's thumb may be extended in the aperture.

Paragraph beginning on Specification page 17, line 4 and ending on Specification page 17, line 10:

In the exemplary embodiment the printer 122 operates to print indicia on the paper to produce the receipt. The printing is generally controlled responsive to the processor such that the length of the receipt when printed does not extend substantially outward beyond the lower edge 119 of the overlying member 30. With the receipt in this position as shown in Figure 39 a user is enabled to extend their thumb or other finger through the aperture 125 [135]. As a result the receipt is engaged in sandwiched relation between the finger of the user and the exterior wall surface 121 of the control panel underlying the receipt.

In the Claims

6. (once amended) The method according to claim 1 wherein the exterior wall includes an opening, and wherein in step (c) [(b)] the receipt extends through the opening, and wherein the overlying member extends from generally above the opening to an edge positioned below the opening, wherein the aperture extends below the opening, and wherein in step (d) the receipt is moved downward by movement of the finger in the aperture.

7. (once amended) The method according to claim 1 wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween [between the overlying member] cannot be manually grasped with fingers prior to moving the receipt by

engagement with a finger through the aperture, and thereafter further comprising manually grasping the receipt.

9. (once amended) The method according to claim 1 and further comprising the step of:


cutting the receipt with a cutter, wherein movement of the receipt in step (d) is operative to cut the receipt [sheet].

Conclusion

Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000